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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,033	02/16/2000	Yasushi Kubota	49087-CIP(820)	5865

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EXAMINER

TRAN, HENRY N

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/506,033

Applicant(s)

KUBOTA ET AL.

Examiner

HENRY N. TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Application has been examined. The original claims 1-60 are pending. The examination results are as following.

#### *Priority*

1. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by

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(1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on April 28, 1998; December 22, 1998; April 13, 1999; February 16, 1999; and May 11, 1999. It is noted, however, that applicant has not filed a certified copy of the first three mentioned applications as required by 35 U.S.C. 119(b).

#### ***Information Disclosure Statement***

3. The examiner has considered the references listed in the information disclosure statement (IDS) filed 2/16/00 (Paper No. 4) (see attached form PTO-1449).

#### ***Specification***

4. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

In the present application:

- Claims 16 and 17, which depend from a dependent claim 9, should not be separated by any claim 10-15, which does not also depend from said dependent claim 9;

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- Claim 29, which depends from a dependent claim 25, should not be separated by any claim 26-28, which does not also depend from said dependent claim 25;
- Claim 58, which depends from a dependent claim 53, should not be separated by any claim 54-57, which does not also depend from said dependent claim 25;
- Claim 57, which depends from a dependent claim 54, should not be separated by any claim 55-56, which does not also depend from said dependent claim 54; etc.

5. The disclosure is objected to because of the following informalities:

The specification refers to specific claims that are not permissible as the claims may be amended in the future. For example, claim 14 is referred in page 83, line 25; claim 4 is referred in lines 4-5 of page 85; claim 18 is referred in lines 21-22 of page 86; claim 5 is referred in line 17 of page 92; etc.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-17, 18-19, and 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases: (i) "or the pulse signal having amplitude smaller than amplitude of the pulse signal" (claim 1); (ii) "to input and stop the supplied clock signal", and "the clock signal having amplitude smaller than the amplitude of the pulse signal" (claim 18), and "the clock signal inputted to the latch circuits is only either one of a clock signal of a

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specified cycle and an antiphase signal of the clock signal” (claim 19); and (iii) “outputting a logical operation result similar to that of the logical circuit” (claims 38-41) are unclear.

It is noted that the pulse signal can be an input pulse signal, e.g., IN, or CK, or the drive voltage Vcc (see figure 2), or an output pulse signal, e.g., OUT or /OUT (see figure 2). How does a pulse signal having an amplitude smaller than the amplitude of itself? It is also noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner suggests that: (i) the claimed limitation “the pulse signal” defined in the base claims 1 and 18 (and therefore the dependent claims 2-17, and 19-36) need to be clarified to avoid it is read on the clock signal, the input signals, such as IN, or /IN, or the output signals such as OUT, or /OUT); and (ii) the claimed limitation “the input signals” defined in the base claim 37 (and therefore the dependent claims 38-60) need to be clarified to avoid it is read on the “a drive voltage”, which is the input voltage Vcc (see figure 2). The examiner was unable to apply prior art for rejecting said above identified claims until the rejections of said above identified claims under 35 USC 112(2) are overcome.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See form PTO-892.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N. TRAN whose telephone number is (703) 308-8410. The examiner can normally be reached on Mon - Fri from 8:00AM - 4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A. HJERPE, can be reached at (703) 305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office Whose telephone number is (703) 306-0377.

*Henry N. Tran*

HENRY N. TRAN  
Examiner  
Art Unit 2674

hnt  
December 18, 2002